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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,249	01/20/2004	Ramiro Liscano	551 (P1149US00)	7076
40604 7590 08/12/2009 MTEL NETWORKS CORPORATION MICHELLE WHITTINGTON, ESQ. 7300 WEST BOSTON STREET CHANDLER, AZ 85226				
EXAMINER STRANGE, AARON N				
ART UNIT		PAPER NUMBER		
24-48				
MAIL DATE		DELIVERY MODE		
08/12/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/759,249

Applicant(s)

LISCANO, RAMIRO

Examiner

AARON STRANGE

Art Unit

2448

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 20090413

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 6/8/09 have been fully considered but they are not persuasive.
2. With regard to claim 1, and Applicant's assertion that Lansio fails to disclose the Internet Appliance replacing the variable name with a value, stored in its own memory, that corresponds to local information of the Internet Appliance (Remarks 4-5), the Examiner respectfully disagrees. The Internet Appliance of Lansio (device containing adapter 420) replaces the variable name (self address tag) with a value (address of the transmitting device) that is stored in the memory of the Internet Appliance (the address information is inherently stored in the memory of the adapter, at least temporarily, since it is added to the outgoing message by the adapter) and that corresponds to "local information" of the Internet Appliance (the address information obtained by and locally stored at the adapter).
3. In the interest of expedited prosecution, the Examiner notes that the disclosed examples of the "real values" used to replace the Internet Appliance Variable appear correspond to information *about* the Internet Appliance itself, rather than merely information "of" the Internet Appliance.

While amending the claims to clarify that the information used to replace the variable is information about the Internet Appliance would be sufficient to differentiate

the claims from Lansio's replacement with information about the transmitting device, the Examiner would like to note that the specific type of information represented by the "real value" that replaces the Internet Appliance Variable is unlikely to patentably distinguish Applicant's claims from the prior art of record, even if it were claimed with sufficient specificity.

The specific type of data used to replace the variable does not functionally change the claimed method or system. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385, 21 7 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

Claim Objections

4. Claim 1 is objected to because of the following informalities: there appears to be a typographical error "Appliance" in line 3. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Lansio et al (US 2003/008640).

7. With regard to claim 1, Lansio discloses a method of operating an Internet Appliance having a network portal (adapter 420) configured to provide a local information of said Appliance to a destination server (name server 412), comprising:

storing in a memory of said Appliance at least one value representative of said Appliance local information in association with a respective variable name (adapter determines the address of the transmitting device and adds it to the outgoing message, which requires storing the address in local memory)(¶44-48);

receiving a message containing a substitutable variable name and addressed to said destination server (adapter receives the message containing the self address tag and addressed to the name server)(¶41-44);

detecting said substitutable variable name in said message (adapter detects the self address tag)(¶44);

replacing said substitutable variable name in said message with said local information from said memory, thereby creating an amended message (adapter substitutes the address information for the self address tag)(¶49); and

sending said amended message to said destination server (adapter transmits the modified message)(¶49).

8. With regard to claim 2, Lansio further discloses that said message and said amended message are formatted according to a text-based Internet protocol (messages may be transmitted as SMS, GPRS or IIOP, which support text-based messages)(¶45-49).

9. Claims 7 and 8 are rejected under the same rationale as claims 1 and 2, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3-5 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lansio et al (US 2003/0008640).

12. In regards to claim 3, Lansio et al. discloses, wherein said text-based Internet protocol is Hypertext Transfer Protocol (§0049 line(s) 10-14, teach the connection being used is an Internet connection, using the IIOP protocol, which supports transmission of text-based messages. However, Lansio et al. does not explicitly teach using HTTP. It would have been obvious to one of one skilled in the art at the time of the invention to use a standardize protocol, such as HTTP, for transmission of messages, because it is reliable and scalable and provides a unified programming model in many environments).

13. In regards to claim 4, Lansio et al. discloses, wherein said text-based Internet protocol is Session Initiation Protocol (§0049 line(s) 10-14, teach the connection being used is an Internet connection, using the IIOP protocol, which supports transmission of text-based messages. However, Lansio et al. does not explicitly teach using SIP. It would have been obvious to one of one skilled in the art at the time of the invention to use a standardize protocol, such as SIP, for transmission of messages, to be used in a telecommunication environment).

14. In regards to claim 5, Lansio et al. discloses, wherein said text-based Internet protocol is Simple Mail Transfer Protocol (§0049 line(s) 10-14, teach the connection being used is an Internet connection, using the IIOP protocol, which supports transmission of text-based messages. However, Lansio et al. does not explicitly teach using SMTP. It would have been obvious to one of to one skilled in the art at the time of

the invention to use a standardize protocol, such as SMTP, for transmission of messages, for sending and receiving email type messages).

15. Claims 9-11 are rejected under the same rationale as claims 3-5, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Strange/
Primary Examiner, Art Unit 2448